168

No. 139.

# SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1906.

No. 139.

Filed Jan. 7, 1907.

CLARENCE W. HOBBS, and GEORGE A. CRAIG, and ISAAC L. PROUTY, Executors of RICHARD SUGDEN, deceased,

*Petitioners,*

v.

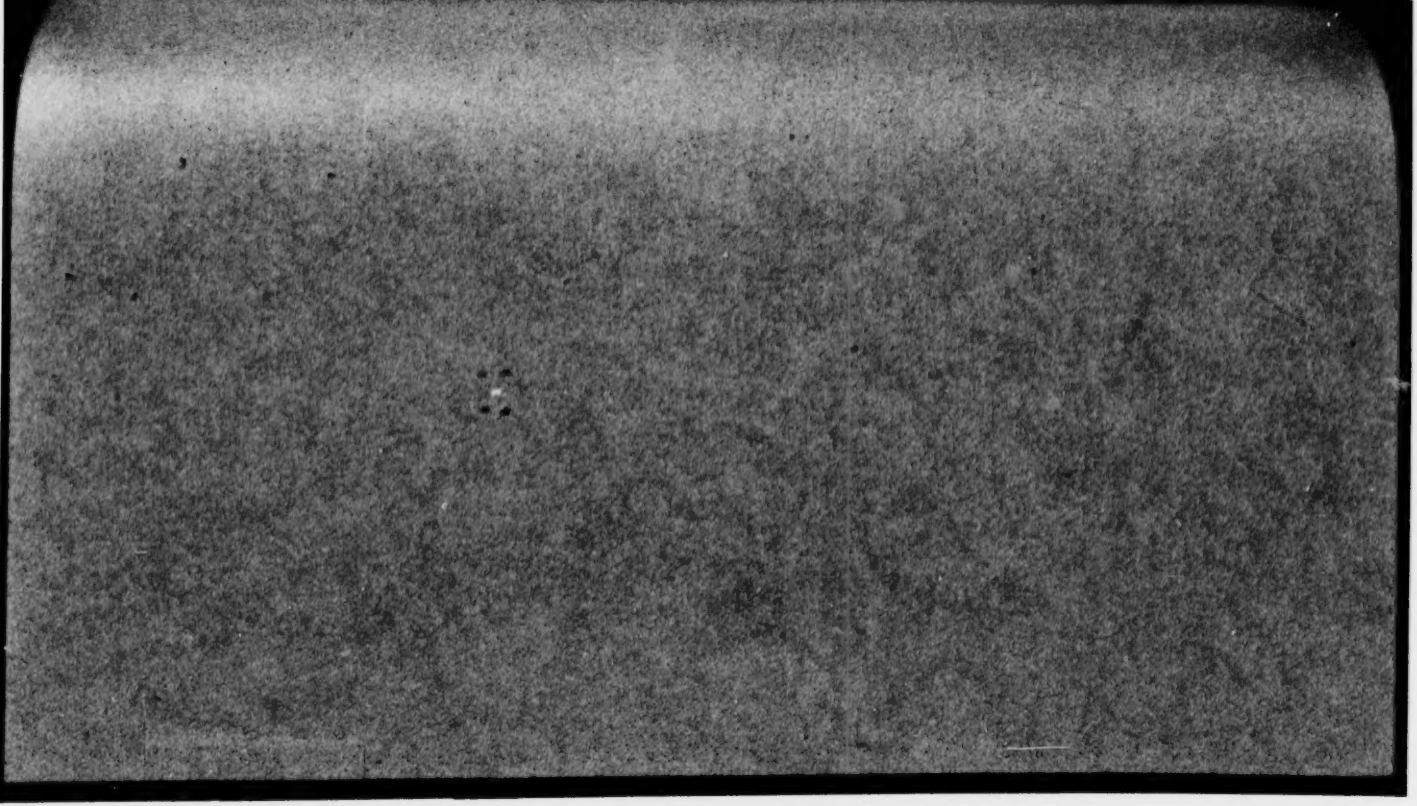
FRED H. BEACH,

*Respondent.*

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

## RESPONDENT'S SUPPLEMENTAL BRIEF.

MR. JOHN DANE, Jr.,
For Fred H. Beach.



# UNITED STATES SUPREME COURT.

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| HOBBS *et al.* | |
| v. | No. 139. |
| F. H. BEACH. | |

## ON WRIT OF CERTIORARI.

### Respondent's Supplemental Brief.

**Petitioners have cited a great number of authorities in their brief filed herein December 5th, that do not apply here, owing to the fact that their theories, concerning defendants' machine and patent therefor, are incorrect;** for example: Petitioners contend that the feeding mechanism of defendants' machine is not the equivalent of the feed of the Beach patent, whereas in fact it is an equivalent. Reasons: The patent calls for, and the claims thereof embrace a feeding mechanism adapted to operate in conjunction with a cutting mechanism and a mechanism for rendering a stay-strip adhesive, and a pair of angular faced dies; the feed of the stay-strip to the cutter and dies is intermittent, and the same is true of defendant's feeding device. The patentee says in his specification that feeding mechanisms other than that described therein may be used, etc. Moreover, the feeding mechanism of defendants' machine was

patented to Van Geasen in July, 1876, and was cited against the application of M. D. Knowlton, who attempted to embrace and claim it. (pp. 262 and 265 Trans). The particular feed of defendants' was therefore old and well known to Van Geason (1876) and Knowlton (1887) long before Horton made his first machine, which (as he testifles, x-Q. 36, p. 29 Trans), was in October, 1889. Consequently, counsel for petitioners cannot properly, nor successfully, contend for and hold that which did not belong to the assignor, (Horton) who, as a fact, made no claim for, nor any pretense of claiming in his application the feeding and cutting mechanism now contended for by counsel.

**The cutter of defendants' machine is precisely the same as the cutter of the Knowlton patent, and substantially the same as that of the Jaeger patent, both in interference with the Beach application, which resulted in decisions in favor of the latter,** and consequently decided that the feed of Knowlton, which had been rejected on the Van Geasen feed, was the equivalent of the feed embraced in the Beach patent. It follows that they were known equivalents of the feeding mechanism of the Beach patent under the rules established by the courts: See Imhaeuser *v.* Buerk, 101 U. S., 647; Morley *v.* Lancaster, 129 U. S., 273, and other cases. Therefore, the claims of the patent in suit lawfully embrace the feeding and cutting mechanism of defendant's machine. Furthermore, the feeding device of defendant operates the same in principle and effect as does the feeding mechanism of the Beach patent, in that both are arranged to feed intermittently a continuous stay-strip from a reel to a pasting or moistening mechanism to a cutting or severing mechanism, where it is severed

into the required lengths to be applied and compressed over and upon the apex of the box corner.

**The sole function and result of the feeding mechanism in complainant's and defendants' machine are precisely alike in all the respects stated.** Their location between the reel and the apex of the anvil are precisely the same, and both are operated by levers. Infringement is clear. Petitioners contend that claims "*one*" and "*two*" of the patent are invalid because certain other elements are not embraced therein. The division of a newly invented machine into combinations of parts less than the whole constituting new inventions is lawful and a customary rule. The case of Bresnahan *v.* Leveller Co., C. C. A., 102 Fed., p. 900 (opinion by Judge Putnam), was one where the same suggestions were made by defendants therein, but overruled by that court.

☞A pioneer in the art, whose invention goes into universal use, will receive a broad and liberal construction. Sessions *v.* Romadka, 145 U. S., pp. 44-45. A pioneer is entitled to a generic claim under which will be included every species included within the genus. In addition to such generic claim, he may include in the same application, specific claims for one or more of the species. Schmidt *v.* Bowers, 25 C. C. A. pp. 348-349, and cases therein cited.

**In short, it is submitted that not one of the many authorities cited in petitioners' brief are in point here.** The question concerning the draughtsman's error in Consolidated Brake Co. *v.* Detroit Steel Co. was one raised by defendant therein as a defense, on the ground that the patent did not by its drawings sufficiently show that which would enable others to construct, etc., as the law requires, yet the specification was ample. The character and cir-

cumstances of that case do not apply here, *in fact, the case as a whole, is in full support of the contentions made for the respondent here.*

The case of Powder Co. *v.* Vigoret Co., 4 Fed., 720 (Petitioners' brief, p. 9), does not apply here; the quotation found in petitioners' brief is not in point, being a mere suggestion only that the courts may question the action of the Commissioners of Patents, under certain conditions which do not exist in the present case.

**Concerning the foreign patent to Jaeger,** said to have expired for non-payment of annuities (Petitioner's Brief, p. 11) it should be noted that this same Jaeger was in interference with Beach and his application was before the United States Patent Office Dec., 1887 (p. 217), and he was also subsequently one of the petitioners in the United States Circuit Court to secure an annulment of the Beach patent, and in both contests failed.

**☞ Beach made oath (pp. 203-204 Trans) that the invention had not been patented to him or to others with his knowledge or consent in any foreign country.**

It is submitted that the Statute (Sect. 4887) concerning the expiration of foreign patents, should be construed to the effect that the American patent expires with the expiration of the earliest foreign patent, granted to the American applicant (patentee) or to his order; and not at the expiration of a foreign patent procured by an unsuccessful applicant and competitor here (U. S.) who had been defeated on issues of priority of invention, etc. *A rule permitting such acts would destroy our Patent system. Any evil-disposed person could apply for a foreign patent for a short term or allow it to lapse for the non-payment of dues and so defeat the bona fide inventor and American patentee by*

*killing his patent in its infancy. The Transcript shows that* (1) That Beach filed his application in the Patent Office June 10th, 1885.

(2) The Jaeger application was put in interference with Beach December 27th, 1887.

(3) Jaeger filed his English application April 5th, 1888, consequently acted with knowledge of the claims of Beach, therefore surreptitious and unfair in his acts, and such as should not impair the right of Beach here. The interference of Jaeger resulted in the award of priority of invention to Beach.

☞Judge Shepley in Kendrick v. Emmons. 2 B. & A., p. 210, said:

"It (the patent) was taken out surreptitiously by "some one who, without the knowledge of the Amer- "ican inventor and without authority from him, en- "deavored to appropriate the benefits of his invention. "If a person had thus surreptitiously taken out let- "ters patent in this country for the invention of "another who was diligently perfecting his invention, "he would not thereby have deprived the real inventor "of any rights. It is not believed that by taking out "in advance an English patent he could accomplish "more than he could have done by taking out letters "patent in this country." Again at p. 211, he said: "But the provision in the act of 1839, with reference "to the effect of his invention having been patented "in a foreign country more than six months prior to "his application, evidently refers to the fact of its "having been patented by him, the applicant of the "American patent."

**Domestic patents do not expire with the expiration of a foreign patent which is lapsed for non-payment of annuities.**

Pohl *v.* Brewing Co., 134 U. S., p. 381.
Welsbach Light Co. *v.* Gas Light Co., 37 C. C. A., 508.

Huber *v.* Manufacturing Co., 148 U. S., p. 274.
Paillard *v.* Bruno, 29 Fed., 864.
Pohl *v.* Hayman, 58 Fed., 568.
Pohl *v.* Brewing Co., 58 Fed., p. 568.
Match Co. *v.* Match Co., 65 Fed., p. 803.

Petitioners suggest in their brief that the following patented devices anticipate the Beach patent, to wit, the

Cohn Patent of 1874—For wire stitching.

Haddan Patent of 1884—For wire stitching.

Inman Patent of 1884—For label and covering.

Gates Patent of 1875—For a box-forming and drying machine.

Sawyer Patent of 1866—For label and tag; no compressing and forming dies.

Maxfield Patent of 1866—For round box covering only; no cutter, no paster, no feeder and no forming dies.

Terry Patent of 1859—No dies, no paster, no feeder, for covering only.

Dennis & York (Addressing)—No angular faced dies and otherwise lacking in essential requisites.

Welsh Patent (Addressing)—No angular dies; an entire reconstruction required.

Beecher & Elliott—Match box machine. This has no pair of angular faced compressing dies, no feeding mechanism for feeding a strip to the corner of a box, and no cutting mechanism for cutting stay-strips for application to box corners. And it is asserted most positively that not a single one of these several patented machines and devices is capable of doing the work, or the kind of work for which the Beach patented machine is intended and adapted.

**The want and desirability of the Beach corner staying machine has been demon-**

**strated in various ways.** (1) The great number of applicants in interference with the Beach application. (2) The abandonment of the wiring machines. (3) The ready and universal adoption of the Beach machine by the box manufacturers, to say nothing of the advantages which have been set forth in respondent's original brief at pages 19 and 20.

**The Beach patented machine is certainly a new combination, and a most valuable one,** and the combinations of the claims in question here, even if they appear simple, now that the story is told, nevertheless are such as the laws intended should be protected.

☞ I might say that the position of Beach is that of Ross in Consolidated Brake Co. *v.* Detroit Steel & Spring Co., 59 Fed., 908-909, in which case Judge Swan said:

"Without essaying to define the line between the "skill of the mechanic and the ingenuity of the in- "ventor, it may be safely affirmed that one who per- "fects a device of confessed utility, which satisfac- "torily supplies a long existing and imperative need "of any branch of industry, and which excels in oper- "ation and results other existing appliances, supersed- "ing them at home and abroad, and by its structure "overcoming difficulties and objections which have "for years baffled the ingenuity of his fellow crafts- "men the world over, including Steel himself, for "whose conception so much breadth is claimed, has "proved beyond cavil that average mechanical skill "was not equal to what he has accomplished. His "success is his individual achievement, the product of "his inventive faculty, not merely that of his training "or vocation. The merit and originality of his device "is not to be determined by the application of a meas- "ure to its parts, or the extent of the difference of form "between it and a contrivance which fails to answer "the same purpose, when that difference, as in this "case, not only produces a desired local effect, but in- "sures the proper operation of the entire device. The "lug or projection in Ross' shoe bearing upon the

" wheel upon the flange and the inner side of the " tread performs a double function. It preserves the " normal shape of that part of the wheel and flange and " aids to equalize the friction surface of the shoe on " each side of the tread. It also prevents the lateral " vibration of the shoe. It is essential to the success " of the device, and is lacking in the steel brake block, " which has no compensating feature. The difference " between these contrasted devices is therefore not " merely in form, but in their mechanical and econom- " ical results. This test and the considerations above " adverted to, establish the originality of Ross' shoe, " and sustain its patentability.

" Examples of patented inventions which have been " upheld by the courts, although they differed very " little in form, mechanism, or operation from other " appliances, are numerous. Krementz *v.* S. Cottle " Co, 148 U. S., 556, 13 Sup. Ct., 719; Loom Co. *v.* " Higgins, 105 U. S., 580; Consolidated Safety " Valve Co. *v.* Crosby Steam Gauge & Valve " Co., 113 U. S., 157, 5 Sup. Ct., 513; Magowan *v.* " Packing Co., 141 U. S., 382, 12 Sup. Ct., 71; The " Barbed Wire Patent, 143 U. S., 275, 12 Sup. Ct., " 443, 450; Gandy *v.* Belting Co., 143 U. S., 587, " 594, 12 Sup. Ct., 598; Topliff *v.* Topliff, 145 U. S., " 156, 163, 12 Sup. Ct., 825.

" For the reasons given, and those mentioned by " Mr. Justice Brown in awarding the injunction in " this cause, there must be a decree for complainants, " with a reference to a master to ascertain damages; " and the injunction is made perpetual."

In Valve Co. *v.* Valve Co., 113 U. S., p. 157, Mr. Justice Brown said Richardson employed things although previously known and used before, *he added thereto just what was necessary to give value and importance to the patented invention.* In Loom Co. *v.* Higgins, 105 U. S., p. 580, the Court held that the new combination of old or well-known elements, *even if old and simple and it increased the product from forty to fifty yards of carpet per day, it was patentable.*

It is submitted that the authorities cited in petition-

ers' brief (pp. 55–56) bearing upon the question of equivalents are of no weight here, in view of the fact that the patent and the art shows that the claims of the Beach patent should be construed broadly, notwithstanding what has been suggested by counsel for petitioners to the contrary. ☞In support of our position on the question of equivalents, see pages 62 and 63 of respondent's first brief.

**The suggested unlawful enlargement of the claims while pending is a myth.** The first claim amendment of May, 1886, p. 205 of Trans., and the first claim of amendment of November 10, 1886, p. 207, are as broad as the very broadest made by Beach, that appears in his patent, which according to the record were made more than three years before Horton even made the first machine of petitioners. Further comments upon this feature of the case seems unnecessary. (See original brief, pp. 43–61.)

☞The cases of Miller *v.* Eagle Mfg. Co., 151 U. S. 208;
Prouty *v.* Ruggles, 16 Pet., 336;
Brooks *v.* Fiske, 15 How., 212;
Eames *v.* Godfry, 1 Wall., 78,

cited by petitioners (p. 54) in support of non-interchangeablilty do not apply to the case at bar, as in every one of the citations referred to the character of the substitution was materially different in principle and operation from the thing of the patent and therefore not an equivalent. Moreover, most of the cases involved were not in any sense pioneer inventions.

The cases cited by the petitioners' counsel bearing upon the functions of the severing device or cutter are not in point here; in fact, they are far-fetched.

The sole object and purpose of the cutter or severing device is to cut a piece from a roll of the stay-strip

material of the proper length required that is to be applied to, folded about and compressed over the corners of the box operated upon,—and it makes no difference whether the cutters are of one particular form or another—if it takes the place with the other essential factors of the patented combination, in the same arrangement, and performs the same functions, —nearly all cutters are adjustable in such locations, in that they permit the cutting of a strip partially or completely off during the operation of such machines as desired by the operator.

☞**The fact is this - the position of petitioners' counsel is based upon the erroneous theory that the Beach patented machine is but an improvement upon pre-existing machines for applying short stay-strips to the corners of paper boxes, yet the records show that in no case or cases referred to have defendants been able to produce or refer to a machine that was capable of doing, or that could do the work for which the Beach machine was intended and adapted.** There was absolutely nothing whatever in the art capable of doing the work of staying or reinforcing the corners of paper boxes with short stay pieces of paper and muslin that could square the corner into perfect form, and immediately dry out the moisture from the adhesive matter. *No machine for this work had been made before that made by Mr. Beach.* Previously, all of such work had been done by the fingers of mankind, which, as the evidence shows, was slow, tedious, uncertain, irregular in form, irregular in adhesion, slow to dry, an excessive waste of stay material by reason of the irregularities in tearing of the stay-strip from the roll (which is generally

held in the hand in rapid work by the fingers), an excessive waste of paste, irregular application of paste by the fingers, is such, that at times there is an excess which dampens and softens the pasteboard from which the box is to be made, which in drying out leaves the box in a crumpled, unshapely and unsightly condition, and at other times there is an insufficient amount of paste applied to properly stay and securely hold the side and end parts of the box together.

By the hand application of the strips, the strip and box becomes daubed and dirty because of the mixture of the dried and fresh paste with dirt which gathers upon the hands of the operator during continued operations upon such work, and because of the discolorations so made, a very thin, delicate covering of finishing paper which is desirable cannot be applied in the final finishing of the box.

The machine for doing this work applies the strip with precision and regularity, cuts it off uniformly, compresses the same about the corner evenly and squarely in a flash of time, and dries out any excess of moisture at the same moment.

The direct application of the strip, and the direct instantaneous action of the compressing dies upon it, is such that no appreciable daub or discoloration is left upon the box or stay.

**In short, it has superseded the wire stitchers, which were the nearest approximations to the new art of which the Beach machine is the pioneer.** As Judge Coxe stated in his opinion (p. 289 Trans.): "None before Beach "had attached adhesive staying strips to box corners "by machinery. No machines in the box-making art, "or in any other art, would do this work. Beach was "the first to accomplish this result." **The contention of petitioners' counsel is to the effect that the combinations of the claims upon**

**which the present suit is based, are lacking in sufficient novelty to support the patent.** This is the usual cry of the infringer who persists in continuing his tortuous acts, it is he who cries, "no invention," "no lawful combination," "undue expansion," "no infringement," and the like, and who also adopts hair-splitting technicalities and proclaims their applicability. It is the grasping at straws for safety when a decree is granted against them.

**In this case not a single instance has been or can be shown from the evidence, of a prior machine that can do the work of the Beach patented combinations.** The evidence shows that tne Beach machine was the very first in the art capable of attaching stay strips by feeding, making adhesive, and presenting the strip over the apex or corner of the box, and severing the strip of the proper length and compressing the same between a pair of dies with angular or diverging faces.

**The difference in the form of the cutting and feeding mechanism of defendants' machine from those of the Beach patent is not material.** They are the same in substance and effect; they are the equivalents of the Beach cutters and feeding mechanism; the office of the feeder and cutter is the same in both. In support of which, I have quoted the following:—

In Imhaeuser *v.* Buerk, 101 U. S., 655-656, Mr. Justice Clifford said, concerning equivalents:

"Equivalents may be claimed by a patentee of an "invention consisting of a combination of old ele- "ments or ingredients, as well as of any other valid "patented improvement, provided the arrangement of "the parts composing the invention is new, and will "produce a new and useful result.

"Such a patentee may doubtless invoke the doc-
"trine of equivalents as against an infringer of the
"patent; but the term 'equivalent,' as applied to
"such an invention, is special in its signification, and
"somewhat different from what is meant when the
"term is applied to an invention consisting of a new
"device on an entirely new machine.

"Pressure in a machine may be produced by a
"spring or by a weight, and where that is so, the one
"is a mechanical equivalent of the other. Cases arise
"also where a rod and an endless chain will produce
"the same effect in a machine, and where that is so,
"the constructor in operating under the patent may
"substitute the one for the other, and still claim the
"protection which the patent confers. Exactly the
"same function in certain cases may be accomplished
"by a lever or by a screw, and where that is so, the
"substitution of the one for the other cannot be re-
"garded as invention.

"Patentees of an invention consisting merely of a
"combination of old ingredients are entitled to equiva-
"lents, by which is meant that the patent in respect
"to each of the respective ingredients comprising the
"invention covers every other ingredient which, in
"the same arrangement of the parts, will perform the
"same function, if it was well known as a proper sub-
"stitute for the one described in the specification at
"the date of the patent Hence it follows that a
"party who merely substitutes another old ingredient
"for one of the ingredients of the patented combina-
"tion is an infringer if the substitute performs the
"same function as the ingredient for which it is so
"substituted, and it appears that it was well known
"at the date of the patent that it was adaptable to
"that use. Gill *v.* Wells, 22 Wall., 1, 28."

In Miller *v.* Eagle Mfg. Co., 151 U. S., 207, Mr. Justice Jackson said.

"The range of equivalents depends upon the extent
"and nature of the invention. If the invention is
"broad or primary in its character, the range of
"equivalents will be correspondingly broad, under the
"liberal construction which the courts give to such in-
"ventions. The doctrine is well stated in Morley

" Machine Co. v. Lancaster, 125 U. S., 263, 273,
" where it is said :

" Where an invention is one of a primary character
" and the mechanical functions performed by the ma-
" chine are, as a whole, entirely new, all subsequent
" machines which employ substantially the same
" means to accomplish the same result are infringe-
" ments, although the subsequent machine may con-
" contain improvements in the separate mechanisms
" which go to make up the machine."

In Sickles v. Borden, 3 Blatch, 541-542-543, Judge Nelson in his charge to the jury *inter alia* said :

" The new form of the machinery embodying the
" new ideas, is not a material part of the patentee's
" invention, for the reason that the embodiment of his
" ideas into working machinery is rather the work of
" the skilful mechanic than that of the inventor.
" Many inventors of improvements in machinery, not
" being mechanics themselves, are obliged to obtain
" the aid of skilful mechanics in embodying their
" ideas in practical working machinery. Different
" mechanics would perhaps embody them by different
" arrangements of machinery—all conforming, how-
" ever, to the principles and ideas of the inventor.
" Hence, the mere form of the defendant's machinery
" must be disregarded, and the jury must look into
" the substance of its arrangement, and its method of
" working, for the purpose of seeing whether the
" ideas of the inventor are incorporated in it. If they
" are, the patent is infringed.

" One of the defendant's experts, an apparently in-
" telligent engineer, inferred that the defendant's
" arrangement was substantially different from that of
" the patentee, because, by following out the specifica-
" tion of the patentee, which minutely describes the
" construction of his apparatus, he could not make
" the arrangement used by the defendant. This prop-
" osition is also embodied in one of the prayers of the
" counsel for the defendant, but its unsoundness is
" obvious, upon an established principle of the patent
" law, which declares that formal changes of ma-
" chinery do not evade a patent. However different,
" apparently, the arrangements and combinations of a

" machine may be from the machine of the patentee, " it may in reality embody his invention, and be as " much an infringement as if it were a servile copy of " his machine. According to the patent law, if the " machine complained of involves substantial identity "with the one patented, it is an infringement. If the " invention of a patentee be a machine, it is infringed " by a machine which incorporates, in its structure " and operation, the substance of the invention; that " is, an arrangement which performs the same service, " or produce the same effect, in the same way, or sub- " stantially the same way.

" In a case before the King's Bench in England " (Walton *v.* Potter, Webster's Pat. Cas., 536), Chief- " Justice Tindall made the following observations, " with every word of which I agree: " Where a party " has obtained a patent for a new invention, or a dis- " covery he has made by his own ingenuity, it is not " in the power of any other person, simply by varying " in form or in immaterial circumstances the nature " or subject matter of that discovery, to obtain either " a patent for it himself, or to use it without leave of " the patentee ; because that would be, in effect and " in substance, an invasion of the right." The Chief- " Justice, therefore, said to the jury : ' What you " ' have to look at upon the present occasion, is not " ' simply whether, in form or in circumstances that " ' may be more or less immaterial, that which has " ' been by the defendants varies from the specification " ' of the plaintiff's patent; but you are to see " ' whether, in reality, in substance, and in effect, " ' the defendants have availed themselves of the " ' plaintiff's invention, in order to make that fabric " ' which they have sold in the way of their trade.' " One machine is the same in substance as another, if " the principle be the same in both, although the forms " may be different."

**The position of Beach is not that of the plaintiff in Prouty v. Ruggles (Plough) ;— in that case the patent was only an improvement upon other patented inventions in the same art,** and his counsel admitted that a certain specified notch in the combination was

called for by the claim, the Court, therefore, held that defendants employed something else, not in any sense a notch, nor anything that could be considered an equivalent of the notch of the patent.

The case of Brooke *v.* Fiske, 15 How., cited by petitioners' counsel, does not in any sense apply to the Beach patent. The planer of the patent in that suit was an improvement in a field largely covered by patents before the patentee entered, and the Court held that the rigid bar of defendant's planer was not the equivalent of plaintiff's roller. In the Boot tree case (Eames *v.* Godfrey, 1 Wall.), cited in support of petitioners' position, the court held that the substitution of an entirely new element, substantially different from the one dispensed with in a combination, was not an infringement because not an equivalent.

The Lantern case (Steam Gauge Co. *v.* Rogers, 29 Fed., 455), cited by petitioners, is rather in support of respondent's position than against, as is the Shutter case (Clark *v.* Wilson, 30 Fed., 373), as well as the Electric Governor case (Electric Co, *v.* Electric Co., 36 Fed., 195), while, ☞ Harmon *v.* Struthers, 43 Fed., 443, opinion by Judge Ackerson, *is substantially our case and the opinion is in support of our contentions.*

**The authorities cited by the petitioners' counsel in support of their theory that the substitution of a new ingredient as a substitute for one removed do not apply to the case at bar,** *for the reason that the machine of defendants does not contain a new ingredient, new element, or a newly invented device as a substitute for one of the essential elements named in either one of the claims in suit*, and the remaining authorities cited by counsel for petitioners which have not been specially referred to on behalf of respondent here, have been carefully read in full, and it

is confidently asserted without fear of contradiction that not a single one of them supports the contentions of petitioners when they are applied to the actual facts in this case. The position of respondent in one of the arts in paper-box making, the character of his invention, patent, and his case as disclosed by the record generally, is quite unlike those referred to in the several cases cited by petitioners' counsel.

All of the theories and points presented in the present case were presented in the cases before the Court of Appeals, in the Second Circuit, at New York before Judges Wallace, Lacombe and Shipman. The record and briefs of defendants used before that Court were before the Court of Appeals in the First Circuit at Boston, and were sent here with other exhibits that this Court might refer to them in case it cared to know the extent and character of the defenses and questions raised by defendants in the Second Circuit.

**It is submitted that petitioners herein are not, so to speak, innocent infringers of the Beach patent.** Their leading manager, Mr. Clarence W. Hobbs, admits that he knew of and had seen the Beach corner staying machines in 1887 (x 26, p. 149 Trans.), and Mr. Horton who made the machine of petitioners, claimed here to be an infringement of the claims in suit, knew of the claims of Mr. Beach and had talked with him about them, and knew of the contests between Horace Inman concerning the question of priority of invention (x-q. 53-54, p. 31 Trans.).

☞Horton had a Beach corner-staying machine of the Beach patent at his shop, at Reading, Massachusetts, early in the year 1889 (x q. 53-54, p. 31 Trans.). In the fall of the same year (Oct.) Horton made the machine involved here (x-q. 36-37, p. 29 of Trans.) and made application March 2d, 1890 (305 Trans.) for a patent with limited claims (as stated in original briefs) to avoid interference with Beach, and offered to

sell the patent to the Hobbs Mfg. Co. (x-q. 63-94, p. 32 Trans.) and to others, *although he had a machine shop and was engaged in building general and special machinery (x q. 37 to 104, inclusive, pp. 37-38 Trans.) he did not care to show his machine to Mr. Beach and get into litigation (x-q. 61-62, p. 32 Trans.) and sold his invention and patent to the Hobbs Mfg. Co., (Clarence W. Hobbs and others) within a week or two after his patent was granted* (x-q. 63-64, p. 32 Trans.) which concern or company thereafter failed and the patent reverted back to Horton, who thereafter resold the same in the early part of 1892 to Richard Sugden, Hobbs' partner, who was then, and formerly, of the said Hobbs Mfg. Co. (x-p. 63, p. 32 Trans.).

☞ *Clarence W. Hobbs, as a manufacturer and dealer in paper-box making machinery, was posted and thoroughly acquainted with the arts in paper-box making. He wanted to compete for a business, by the manufacture and sale of a machine capable of doing mechanically that which had formerly been done by hand only, containing the combination of certain essential elements which had been previously invented by Beach, who was using due diligence in contesting before the Patent Office in a lawful way for his own rights to such, which eventually resulted in the grant and issue of the broad claims to the applicant, which combinations have been adopted by petitioners,* (defendants), *without leave or license.* Mr. Hobbs admitted during his cross-examination that the essential elements of the Beach patented machine are (1) "The pasting apparatus"; (2) "the feeder"; (3) "cut off," and (4) "the angular faced clamps" (dies) (x-q. 16, p. 149 Trans.). He also admits that the Beach machine is not useful for purposes other than for staying the corners of boxes (x-q. 22, p. 149 Trans.). He also admits that the so-called Knowlton & Beach machine contains as essential elements (1) a pasting apparatus; (2) a feeding apparatus; (3) a cutting apparatus, and (4) means for supporting

the corners of boxes or covers thereof, and a movable counterpart (angular faced die) for compressing the stay-strip upon the corners, etc. (x-q. 23, p. 149 Trans.).

**The evidence herein shows and the Patent Office and Courts have decided that the so-called Knowlton machine was and is in substance and in all essential parts the machine of the patent to Beach** (respondent), which is practically the same as the Horton machine.

☞Hobbs admits in answer to x-q. 99 (p. 155 Trans.), that it matters not whether the stay-strip is fed across the corner of the box from the side or from the rear in a direction of its depth in the line of its corner, the result is practically the same in both. Hobbs also admits the V-shaped pasting wheel of defendants' machine, applies the paste or moisture to the underside of the stay-strip in the same manner and for the same purpose as the flat surface of the Beach pasting or moistening wheel (x-q. 161 to 164 Trans.), also that the result in the application of the stay-strip to the corner of the box would be the same, whether applied by the feeder from side or rear direction (x-q. 173-174, p. 165 Trans.), and whether the stay-strip is fed to the box corner from side or rear, the cutter in defendants' as well as in the machine of the Beach patent, is adapted to be adjusted for severing the strips of the desired lenghts (x-q. 175-176, p. 165 Trans.).

In conclusion, it is submitted that there was no error in the conclusions of the Court of Appeals, therefore its decision should be affirmed by this Court with full costs of this and the courts below to respondent.

JOHN DANE, JR.,
For the Respondent.